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31 JAN 2008

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Houston, Texas 77002      winstead.comFrom the desk of: Cherita  
GrimsteadDate: January 31, 2008  
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<b>Recipient</b>	<b>Company</b>	<b>Phone #</b>	<b>Fax #</b>
1. Examiner A. Smith	USPTO	571/272-3298	571/273-0459
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**Message**

Supplemental Declaration filing per our conversation on January 30, 2008 for Application No. 10/575,352.

If any transmission problems, please call: 713.650.2402

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ATTORNEY DOCKET NO.  
11321-P077WOUS

PATENT  
Serial No. 10/575,352

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Richard E. Smalley, Deceased, et al.  
Serial No: 10/575,352  
International App'l No: PCT/US2004/34002  
Int'l Filing Date: October 14, 2005  
Group Art Unit: Unknown  
Confirmation No: 9430  
Title: Amplification of Carbon Nanotubes Via Seeded-Growth Methods

Mail Stop PCT  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**RENEWED SUBMISSION UNDER 37 CFR 1.42**

In response to the Decision on Papers Under 37 CFR 1.42 with the mail date of June 11, 2007, with two-months to provide a response ending on August 11, 2007, Applicant encloses the following documents:

1. Declaration in compliance under 37 CFR 1.497(a)-(b) executed by Irene M. Marek, legal representative of deceased inventor Richard B. Smalley;
2. Supplemental Declaration Under 37 CFR 1.42 executed by Irene M. Marek; and
3. A copy of the Decision on Papers Under 37 CFR 1.42;

ATTORNEY DOCKET NO.  
11321-P077WOUS

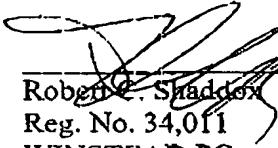
PATENT  
Serial No. 10/575,352

Applicant does not believe there are any fees due at this time; however, if there any fees required, Commissioner is hereby authorized to charge any fees relating to this filing to the Winstead Sechrest & Minick P.C. Deposit Account No. 23-2426. Any questions regarding this filing should be directed to the attorney below.

Dated:

8/13/07

Respectfully submitted,

  
\_\_\_\_\_  
Robert E. Shaddox  
Reg. No. 34,011  
WINSTEAD PC  
P.O. Box 50784  
Dallas, TX 75201  
Tel (713) 650-2764  
Fax (214) 745-5390

ATTORNEY FOR APPLICANTS

**CERTIFICATE OF TRANSMISSION OR MAILING UNDER 37 C.F.R. § 1.10**

I hereby certify that the attached *Response to Notice Notification of Missing Requirements* is being filed electronically with the United States Patent and Trademark Office via EFS-Web on the date below:

August 13, 2007

Date

  
\_\_\_\_\_  
Signature

928121v.1 11321/P077WOUS



## UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
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 P.O. Box 1450  
 Alexandria, VA 22313-1450  
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11 JUN 2007

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JUN 15 2007

Ross Spencer Garson  
 Winstead Sechrest & Minick P.C.  
 P.O. Box 50784  
 Dallas, Texas 75201

BY WINSTEAD

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JUN 18 2007

In re Application of :  
 SMALLEY et al. :  
 Application No.: 10/575,352 :  
 PCT No.: PCT/US04/34002 :  
 Int. Filing Date: 14 October 2004 :  
 Priority Date: 14 October 2003 :  
 Attorney Docket No.: 11321P077WOUS :  
 For: AMPLIFICATION OF CARBON  
 NANOTUBES VIA SEEDED-GROWTH  
 METHODS

DECISION ON  
 PAPERS UNDER 37 CFR 1.42

By MJT

This decision is issued in response to the declaration filed 19 April 2007 which is being treated as a request under 37 CFR 1.42. No petition fee is required.

BACKGROUND

On 14 October 2004, applicants filed the above-identified international application which claimed a priority date of 14 October 2003. Pursuant to 37 CFR 1.495 the deadline for payment of the basic national fee was to expire 30 months from the priority date, 14 April 2006.

On 11 April 2006, applicants filed a transmittal letter for entry into the national stage in the United States accompanied, inter alia, by: the basic national fee; a copy of the international application; and a preliminary amendment.

On 19 April 2007, applicants filed a declaration executed by twelve of the thirteen inventors and Irene M. Marek, on behalf of deceased inventor, Richard E. Smalley.

DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Application No.: 10/575,352

2

The declaration filed on 19 April 2007 is executed by twelve of the thirteen inventors and Irene M. Marek as the "legal representative" of the deceased inventor, Richard E. Smalley. The declaration submitted appears to have been executed by the proper party under 37 CFR 1.42, however, the declaration does not satisfy the requirements under 37 CFR 1.497(b)(2).

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), in addition to the citizenship and former residence and post office address of the deceased inventor referenced under 37 CFR 1.497(a)(3) and 37 CFR 1.63, the declaration must also provide name, residence, citizenship, and post office address for the legal representative. In this case, the declaration filed on 19 April 2007 provides the residence, citizenship, and post office address for only one individual and it is unclear whether this information is for the legal representative or the deceased inventor. Accordingly, the declaration is not in compliance with 37 CFR 1.497(b)(2).

Additionally, the declaration is not in compliance with 37 CFR 1.497(a)-(b) in that it gives the impression that Irene M. Marek is the first or sole inventor for the present application. A compliant declaration under 37 CFR 1.497(a)-(b) would identify the inventors as they appear in the published International Application. In order to proceed under 37 CFR 1.42, applicant must provide a declaration that: (1) properly identifies the inventors; (2) sets forth the residence, post office address and country of citizenship for both the deceased co-inventor, Richard E. Smalley and the legal representative, Irene M. Marek; and (3) states the relationship (i.e. legal representative or sole heirs) of Irene M. Marek to the deceased inventor.

### CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is REFUSED.

Applicants are required to provide an oath/declaration in compliance with 37 CFR 1.497(a)-(b) within **TWO (2) MONTHS** from the mail date of this Decision. Failure to respond will result in the abandonment of the application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42" and must include an acceptable declaration under 37 CFR 1.497 which has been executed by the

Application No.: 10/575,352

3

either the legal representative of the deceased inventor or, if no legal representative has been appointed, all of the heirs of the deceased inventor.

Any further correspondence with respect to this matter should be addressed to:  
Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box  
1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the  
attention of the Office of PCT Legal Administration.

Anthony Smith

Anthony Smith  
Attorney-Advisor  
Office of PCT Legal Administration  
Tel: (571) 272-3298  
Fax: (571) 273-0459

**SUPPLEMENTAL DECLARATION UNDER 37 C.F.R. § 1.42  
FOR SIGNING BY LEGAL REPRESENTATIVE ON  
BEHALF OF DECEASED INVENTOR**

I, Irene M. Marek, hereby declare that I am a citizen of the United States, residing at 3 Stagestop Circle, Houston, Texas 77024. I further declare that I have been appointed as a legal representative of Richard E. Smalley, who passed away on October 28, 2005, as I am named as executrix in his will. Upon information and belief, I aver those facts that he is required to state in order to apply for a patent or allowance of my patent application in which he is listed as an inventor. Further, it is my understanding that this patent application in which Richard E. Smalley is listed as an inventor is to be assigned to Rice University, his employer since 1976, pursuant to the Rice University Policy.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under §1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: 8/10/07

Irene M. Marek

Irene M. Marek  
Legal Representative of Richard E. Smalley

Houston\_1\924196\1  
11321-P077WOUS 7/24/2007